

REMARKS

The drawings stand objected to for minor informalities. It is respectfully submitted that the enclosed replacement drawings for Figures 8-10 obviates this issue. Accordingly, it is respectfully requested that this objection be withdrawn.

The specification stands objected to for minor informalities. Regarding the objection to “silicon oxide film (SiO₂)” as used in the specification, it is respectfully submitted that “silicon oxide” is recognized in the art as a generic term embodying silicon-oxide compositions whereas silicon dioxide (SiO₂) is a species thereof. Accordingly, it is respectfully submitted that the phrase “silicon oxide film (SiO₂)” in the specification simply identifies SiO₂ as one exemplary embodiment of a silicon oxide film. With regard to the remaining objections, it is respectfully submitted that the enclosed amendment obviates the alleged informalities. Accordingly, it is respectfully requested that this objection be withdrawn.

Claims 1, 5 and 6 stand objected to for minor informalities. It is respectfully submitted that the enclosed amendment obviates the alleged informalities. Accordingly, it is respectfully requested that this objection be withdrawn.

Claim 1 is independent and stands rejected under 35 U.S.C. § 103 as being unpatentable over Song et al. ‘320 (“Song”) in view of Applicants’ admitted prior art (“AAPA”). This rejection is respectfully traversed for the following reasons.

Claim 1 recites in pertinent part, “an outer face of said case is coated by a nonmetallic material in which a deforming temperature is higher than a charge dissipating temperature of said

dielectric layer that becomes said electret.” The Examiner admits that neither Song nor AAPA discloses or suggests such a feature. However, the Examiner merely concludes that such a feature would have been obvious without any prior art support for his position. It is respectfully submitted that the Examiner’s rejection effectively defines an improper use of hindsight reasoning, where the Examiner relied solely on Applicants’ specification as the source for motivation to make the modification of the cited prior art needed to reach the claimed invention.

In this regard, it is noted that the Examiner relies on paragraph [0022] of Song as disclosing the use of materials PEEK, PEN and PES as high-temperature resistant materials used in an electret condenser microphone. However, at paragraph [0022], Song expressly states that “the back-plate 210, the spacer 208, the diaphragm 206 and the first base 212 are all made from a fluoro resin-, polymer- or plastic-based material having a heat- and chemical-resistant characteristic ... according to the present invention, a high-temperature resistant material is used *for components* of the electret condenser microphone” (emphasis added). That is, the disclosure of high-temperature resistant materials in Song is expressly directed to the *internal components* of the microphone within the case, and is completely unrelated to an outer coating of the case holding said internal components therein. Indeed, another one of the high-temperature resistant materials disclosed by Song for internal components (i.e., FEP; page 2, right column, line 1) is also described in Applicants’ specification as a conventional material for said internal components (*see, e.g.*, page 1, line 23 of Applicants’ specification). As such, Song is at best cumulative to the admitted prior art described in the Background Art section of Applicants’ specification, and is subject to the same drawbacks identified solely by Applicants.

Indeed, one of the objectives of the present invention is to enable obviating the drawbacks of conventional devices such as in Song. As described on page 3, line 18 – page 4, line 24 of

Applicants' specification, conventional devices such as disclosed by Song do not have thermal resistance against the Pb-free reflow temperature used when mounting the device *externally* to, for example, a cellular phone. Accordingly, when mounting the conventional device of Song to a cellular phone using reflow, charges escape from the electret. Only Applicants have recognized this specific issue, and conceived of a novel structural configuration which can make it possible to obviate said issue; whereby a microphone can be attached, without functional impairment, to application-equipment by passing through a reflow solder bath. Song, on the other hand, is completely silent as to drawbacks related to reflow soldering the device for external attachment and is related only to internal parameters within the case.

Accordingly, outside of Applicants' specification, there is no motivation or suggestion for providing "an outer face of said case is coated by a nonmetallic material in which a deforming temperature is higher than a charge dissipating temperature of said dielectric layer that becomes said electret" as recited in claim 1. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplicatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 1 is patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination. Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 103 be withdrawn.

Claims 1-7 stand rejected multiple times based on non-statutory obviousness-type double-patenting over various patents/applications. These rejections are respectfully traversed because the Examiner does not provide any legal/technical basis for alleging that the features of the claims of the present application would have been obvious over the claims of the respective patents/applications (hereinafter, "OTHER CLAIMS"). Indeed, the Examiner makes no comparison between the claims of the present application and the OTHER CLAIMS.

Accordingly, it is submitted that the Examiner has not established a *prima facie* showing of obviousness. The Examiner is directed to MPEP § 804(II)(B)(1), which sets forth the applicable standard for issuing a obvious-type double patenting rejection:

any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination

In the instant case, the Examiner does not provide any analysis for alleging obviousness per §103 analysis. For example, the Examiner does not acknowledge the specific differences between any of claims 1-7 and the OTHER CLAIMS, let alone indicate why such differences would have been obvious in view of the standard set forth under § 103 using objective evidence. The Examiner has not provided any factual support for the allegation of obviousness under §103, whereby factual inquiries set forth in *Graham v. John Deere Co.* must be made and supported by evidence on the record.

The Examiner must set forth why one of ordinary skill in the art, based on *objective* evidence, would find claims 1-7 obvious over the OTHER CLAIMS and provide the requisite rationale to support such an allegation. In the instant case, however, the Examiner merely *concluded* that claims 1-7 are not patentably distinct from the OTHER CLAIMS. The Examiner's allegation does not support obviousness, nor provide any of the requisite evidence needed to show *prima facie* obviousness.

Examiner's allegation does not support obviousness, nor provide any of the requisite evidence needed to show *prima facie* obviousness.

Moreover, as noted above with respect to the § 103 rejections, only Applicants have recognized and considered the aforementioned effects, and conceived of the non-obvious combination which can make it possible to realize said effects. Outside of Applicants' specification, there is no disclosed need or desire, nor any suggestion whatsoever, to modify the OTHER CLAIMS to reach the claimed invention.

Based on the foregoing, it is respectfully submitted that claims 1-7 of the present application are patentably distinct over the OTHER CLAIMS.

CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

Application No.: 10/589,281

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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